

REMARKS

Claims 83-87 have been added. Claims 51-53, 55-59, and 62-87 are pending in the application.

Claims 62-67 and 80 are allowed.

Claims 51-53, 55-59, 68-79 and 81-83 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al or Oikawa (JP5-102067 from IDS) in combination with Pan '525. Claims 55-59, 68-75, 79, and 81 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner et al in Pan '525.

Regarding the obviousness rejection against claim 51 based on Suzuki or Oikawa in combination with Pan, the Examiner is respectfully reminded that “[p]referably the Examiner’s explanation should be such that it provides that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification.” *Ex Parte Levingood*, 28 USPQ2d, 1300, 1301, Footnote 2, (Bd. Pat. App. and Inter. 1993) (citations omitted). The motivational rationale provided by the Examiner is stated as, it would have been obvious to one of ordinary skill in the art to have concentration in the invention of Suzuki or Oikawa because such concentration in Pan is suitable for hot electron carrier suppression. However, the Suzuki and Oikawa inventions teach that such inventions are suitable for hot electron carrier suppression (background and summary of Suzuki; paras. 0004-0006, pg. 4 of Oikawa), and therefore, the alleged motivational rationale to modify the Suzuki and Oikawa inventions is redundant. One skilled in the art with the teachings

of the Suzuki and Oikawa inventions would not look to Pan for redundant teachings. Accordingly, the Examiner's explanation is completely devoid of that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification, pursuant to the above authority. For at least this reason, the motivational rationale to modify the Suzuki and Oikawa inventions must fail. Accordingly, since the motivational rationale fails, the obviousness rejection against claim 51 must also fail and should be withdrawn.

Moreover, since the Examiner provides a motivational rationale that is redundant, the Examiner is effectively stating that the references can be combined, and therefore it is obvious do so, without presenting any desirability of the combination contrary to established Federal Circuit Law and M.P.E.P. authority. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01 (8th edition) *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so". 916 F.2d at 682, 16 USPQ2d at 1432; MPEP §2143.01; See also *In re Finch*, 972 F.2d, 1260, 23 USPQ2d, 1780 (Fed. Cir. 1992). The Examiner has failed to provide the desirability for the modification as required for a proper obviousness rejection, pursuant to the authority above. For this additional reason, the obviousness

rejection against claim 51 is inappropriate and should be withdrawn. Claim 51 is allowable. Applicant respectfully requests allowance of claim 51 in the next Office Action.

Claims 52-53, 76-78, 82-85 depend from independent claim 51, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not taught or shown by the art of record.

Regarding the obviousness rejection against independent claims 55 and 68 based upon the combination of Gardner and Pan, the Examiner respectfully fails to provide any motivational rationale for the combination of art (pg. 4 of paper no. 26). The Examiner is respectfully reminded that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th edition). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggesting, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP §2143.01 (8th edition) *citing In re Fine*, 837 F.2d

1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Such authority clearly demonstrates that a motivational rationale to modify or combine references to teach the claimed invention is imperative for a proper obviousness rejection.

Contrary to the above authority, the Examiner completely fails to provide the required motivational rationale for the combination of art, and therefore, the obviousness rejection against independent claims 55 and 68 must fail and should be withdrawn. Applicant respectfully requests allowance of independent claims 55 and 68 in the next Office Action, or **at least another non-final Office Action** with a proper rejection against claims 55 and 68.

Claims 56-59, 79 and 86 depend from independent claim 55, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not taught or shown by the art of record.

Claims 69-75, 81 and 87 depend from independent claim 68, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not taught or shown by the art of record.

In view of the foregoing, allowance of the pending claims is requested. The Examiner is requested to phone the undersigned in the event that the next Office Action is one other than a Notice of Allowance. The undersigned is

available for telephone consultation at any time during normal business hours
(Pacific Time Zone).

Respectfully submitted,

Dated: 1-02-03

By:



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 09/292,132
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Inventor Salman Akram et al.
Assignee Micron Technology, Inc.
Group Art Unit 2812
Examiner S. Mulpuri
Attorney's Docket No. MI22-1171
Title: Methods of Forming A Transistor Gate

VERSION WITH MARKINGS TO SHOW CHANGES MADE ACCOMPANYING
RESPONSE TO OCTOBER 2, 2002 OFFICE ACTION

In the Claims

The claims have been amended as follows. Underlines indicate insertions and ~~strikeouts~~ indicate deletions.

There are no amendments to the claims.

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